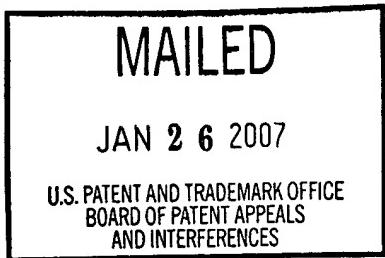


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. FREDLUND, JOSEPH A. MANICO,
and RICHARD G. MACKSON



Appeal No. 2006-1418
Application No. 09/213,169
Technology Center 3700

ON BRIEF

Before OWENS, LEVY, and FETTING, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-36 and 40-63¹, which are all of the claims pending in this application.

We AFFIRM.

¹ Although appellants state (Brief, page 1) that claims 1-36 and 40-63 are on appeal. We find no rejection of claims 11 and 47.

BACKGROUND

The appellants' invention relates to a system for displaying, storing and retrieving images (spec., p. 1). Claim 1 is representative of the invention, and is reproduced as follows:

1. An album leaf having a first side having a first image retaining section and a second side having a second image retaining section, said first image retaining section on said first side having a plurality of images and a first icon formed thereon, said first icon individually identifying the source from which said plurality of images originated.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Shiota	4,903,068	Feb. 20, 1990
Werner et al. (Werner)	5,709,496	Jan. 20, 1998
Manico et al. (Manico)	5,764,870	Jun. 9, 1998
Combs	5,782,349	Jul. 21, 1998
Manico et al. (Manico)	5,791,692	Aug. 11, 1998

Claims 1, 7, 12, 13, 19, 23-25, 29, 34, 35, 40, 43, 44, 46, 50-52, 57, 58, 62, and 63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Manico ('692) in view of Shiota.

Claims 2-6, 14-18, 26-28, 30, 36, 41-45, and 53-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Manico ('692) in view of Shiota and Manico ('870).

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Claims 8, 20, 31, 37, and 59 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Manico ('692) in view of Shiota and Werner.

Claims 9, 10, 21, 22, 32, 33, 48, 49, 60, and 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Manico ('692) in view of Shiota and Combs.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed March 11, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed November 19, 2003) and reply brief (filed March 24, 2004) for the appellants' arguments thereagainst.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 C.F.R. § 41.37(c)(1)(vii)(eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

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Upon consideration of the record before us, we make the determinations which follow.

We begin with the rejection of claims 1, 7, 12, 13, 19, 23-25, 29, 34, 35, 40, 43, 44, 46, 50-52, 57, 58, 62, and 63 under 35 U.S.C. § 103(a) as being unpatentable over Manico ('692) in view of Shiota. We note as background that in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. *In re Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. *Id.* at 1343. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings." *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching,

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motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also *In re Thrift*, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. *Note In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Id.*; *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, pages 3 and 4) is that Manico et al. lacks the disclosure of first and second icons for identifying first and second sources of the memory images on the photographic sheets.

To overcome this deficiency of Manico ('692), the examiner turns to Shiota for a teaching of a photographic sheet comprising an icon (64) with an image ID (65) inside the silhouette (60a, 61a). The examiner asserts that the modification would have been obvious in order to categorize the content and provide more information on the images.

Appellants assert (brief, page 3) that images may come from a variety of different rolls of film, and that a problem exists when the user wishes to retrieve the original image for later use, because it is extremely difficult to know where the images on the album leaf originated. It is asserted to the effect that the present invention solves this problem by providing an album leaf where the images and icons are integrally formed on the album leaf.

Appellants point out (*id.*) that independent claims 1, 40, and 52 set forth that the icons provide information individually identifying the source from which the plurality of images originate. Appellants acknowledge (brief, page 4) that Shiota discloses an index print having individual frame numbers. It is asserted (*id.*) that "frame numbers are nothing more than the position on which they occur on the roll of film. They themselves do not identify the source in which the images originated. In fact, there is nothing to indicate in Shiota et al. that there is any identification information for which the images placed thereon can be associated with the original image source." It is argued that in Shiota, "the images are basically printed at the same time the actual size of the service prints are provided," and that these are typically packed in the same envelope and returned to the customer. Appellants add (*id.*) that the frame number disclosed in Shiota merely refers to frame of film from which the index print is associated. The frame number does not specifically identify the specific roll of film to which the present invention is directed. The '870 reference is believed [by Appellants] to be of little or no relevance to the present invention. Appellants further assert that neither Manico ('692) nor Shiota teach the use of icons which individually identify the

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source from which the images came from. Appellants additionally argue (*id.*) that there is no motivation to combine the teachings of Manico ('692) and Shiota.

Before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. *See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to appellants' claim 1 to derive an understanding of the scope and content thereof.

Before turning to the proper construction of the claim, it is important to review some basic principles of claim construction. First, and most important, the language of the claim defines the scope of the protected invention. *Yale Lock Mfg. Co. v. Greenleaf*, 117 U.S. 554, 559 (1886) ("The scope of letters patent must be limited to the invention covered by the claim, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the specification."); *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 396, 155 USPQ 697, 701 (Ct. Cl. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth [in the claim]."). *See also Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 419 (1908); *Cimiotti Unhairing Co. v. American Fur Ref. Co.*, 198 U.S. 399, 410 (1905). Accordingly, "resort must be had in the first instance to the words of the claim" and words "will be given their ordinary and accustomed meaning, unless it

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appears that the inventor used them differently." *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984). Second, it is equally "fundamental that claims are to be construed in the light of the specification and both are to be read with a view to ascertaining the invention." *United States v. Adams*, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966).

Furthermore, the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim must be followed. *See In re Priest*, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). One must be careful not to confuse impermissible imputing of limitations from the specification into a claim with the proper reference to the specification to determine the meaning of a particular word or phrase recited in a claim. *See E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir.), *cert. denied*, 488 U.S. 986 (1988).

What we are dealing with in this case is the construction of the limitations recited in the appealed claims. As stated by the court in *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) "[t]he name of the game is the claim." Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

We find that claim 1 recites a first icon and that the icon individually identifies the source from which the plurality of images originated. The claim only requires a single source for the images and does not require that the images come from more than one source. Nor does the claim require that the icon identifies the

source from among a plurality of image sources. In addition, while the claim recites individually identifying the source, the claim does not recite uniquely identifying the source.

With this claim interpretation in mind, we turn to the teachings and suggestions of the prior art. Manico ('692) discloses an album leaf having a plurality of images thereon, but does not disclose an icon that individually identifies the source of the images. Turning to Shiota, we find that as noted by both the examiner (answer, page 4) and the appellants (brief, page 4), Shiota discloses a roll of developed pictures that includes an index print, where each index print includes a frame number located on the print (see figure 2). It is disclosed (col. 4, lines 26 and 27) that frames 60a, 61a, and 63a are reduced in size from numerically corresponding frames 60, 61, and 63. Frames 60a, 61a, and 63a are inlaid in a single composite image frame 64 as an index print, and are arranged in a 4x4 matrix (col. 4, lines 28-30).

From the disclosure of Shiota, we find that the frame included in the index print represents a plurality of icons. From the disclosure of index print numbers on each print, we find that each of the icons includes a representation of the source of the image. If a user has a single roll of film developed, the numbers on the index print identify the source of the image, e.g., frame 1, of the roll of film, frame 2 of the roll of film, etc. As such, for a single roll of developed film, each icon individually identifies the roll of film that is the source of the image. From the disclosure of Shiota of developing a roll of film, with the developed film including an index print, we find that an artisan would have been motivated to provide the album leaf of Manico ('692) with index prints that identify the source of the

images, i.e., the frame numbers of the images from the developed roll of film. Accordingly, we are not persuaded by appellants assertion (reply brief, pages 2 and 3) that there is no motivation to combine the teachings of Manico ('692) and Shiota.

We are not persuaded by appellants' assertion (brief, page 3) that the images may come from a variety of different rolls of film. As noted, *supra*, claim 1 does not require that the images come from more than one roll of film.

Nor are we persuaded by appellants' assertion (*id.*) that a problem exists when the user wishes to retrieve the original image for later use, because it is extremely difficult to know where the images on the album leaf originated. As broadly claimed, all of the images can be from a single roll. If all of the images are from a single roll, it would not be "extremely difficult" to know where the images originated. In addition, by providing index prints having frame numbers thereon, the user can readily determine where the image came from in the roll.

Nor are we persuaded by appellants' assertion, (*id.*), that the present invention solves the problem of identifying the roll by providing an album leaf where the images and icons are integrally formed on the album leaf. Firstly, claim 1 does not recite that the images and icons are integrally formed on the album leaf. Secondly, in Shiota, the images and index prints having the frame numbers of the images are integrally formed on the photographic paper as shown in figure 2.

Nor are we persuaded by appellants' assertion (*id.*), that claims 1, 40, and 52 set forth that the icons provide information individually identifying the source from which the plurality of images originate. The claims do not recite that each source has a unique ID number. If all of the images are from a single roll, each of the

frame numbers individually identify the source of the images by identifying where in the roll the particular frame number is located. We note that the prior art does not provide each source with a unique ID number, and does not distinguish one source from among plural sources. However, these limitations do not appear in any of claims 1, 40 or 52.

Nor are we persuaded by appellants' assertion, (*id.*), that the frame numbers of Shiota do not identify the source in which the images originated. The frame numbers would not identify the source roll if the claims recited that each source roll has a unique (ID.) that is identified by the icon. Nor would the frame numbers identify the source roll if more than one source roll were claimed. However, as claim 1 only requires a single source roll we find, as stated, *supra*, that each frame number identifies the source roll and the location of the image on the source roll, if there is only one source roll. Accordingly, we are not persuaded by appellants' assertion that neither Manico ('692) nor Shiota teach the use of icons which individually identify the source from which the images come from.

From all of the above, we find that the combined teachings and suggestions of Manico ('692) and Shiota would have suggested to an artisan the invention of claim 1, and are not convinced of any error on the part of the examiner in rejection claim 1, 40, or 52 under 35 U.S.C. § 103(a) in view of the breadth of appellants' claims. The rejection of claim 1 under 35 U.S.C. § 103(a) is sustained, along with claims 7, 12, 13, 19, 23-25, 29, 34, 35, 40, 43, 44, 46, 50-52, 57, 58, 62, and 63, which fall with claim 1.

We consider next to the rejection of claims 2-6, 14-18, 26-28, 30, 36, 41-45, and 53-56 under 35 U.S.C. § 103(a) as being unpatentable over Manico ('692) in

view of Shiota and Manico ('870). We turn to representative claim 2. The examiner's position (answer, page 4) is that Manico as modified by Shiota does not disclose "an origination ID being associated with at least one of a plurality of images which indicates the first source." To overcome this deficiency of Manico ('692) and Shiota, the examiner turns to Manico ('870) for a teaching of a photographic sheet comprising an origination ID. The examiner asserts, (*id.*), that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Manico et al. as modified by Shiota with an origination ID inside the silhouette as taught Manico et al ('870) to indicate the identification images and the location of the images on the photographic sheet.

Appellants assert (brief, page 5) that these claims further set forth that the icon comprises a silhouette of the plurality of images provided on that side of the album leaf. It is argued that in addition, the icon may provide additional information as to the format of the image and the frame number of the image on the original source. It is additionally argued, (*id.*), that there is no teaching or suggestion in either of the two cited references of providing an icon in the form of a silhouette as taught and claimed by appellants. In the reply brief, appellants assert (page 2) that the thumbnail images of Shiota are not silhouettes, and relies upon two dictionaries for definitions of a silhouette. With respect to the examiner's additional reliance on Manico ('870), it is argued that Manico ('870) is directed to an album leaf , while Shiota is directed to a photographic printer for printing images on photographic paper. It is argued (*id.*), that there is no teaching or suggestion for combining the references, nor any motivation to do so.

We note at the outset that claim 2 does not recite that the icon provides information such as the particular format of the image. As to appellants' assertion that the claim recites the frame number of the image on the original source, we note that Shiota discloses (figure 2) putting the frame number on the index print. With regard to the claimed silhouette, we note from appellants' specification (page 6) that as illustrated in Figs. 1 and 2, icons (reference indicia) 50, 64, 66 are provided for identifying each of the images (15-25) and the source from which the images originate. In particular, referring to icon 50, it comprises a plurality of silhouettes (an outline representation of the edges) of the actual images 15, 16, 17, 18, 19 provided on the first side 12. Additionally, the icons may be composed of thumbnail (miniature) image representations of the actual images. In particular, there are provided silhouettes 55-59, each of which refer to the location of its respective images 15-19.

From the language in the specification (page 6) we find that that:

As illustrated in Figs. 1 and 2, icons (reference indicia) 50, 64, 66 are provided for identifying each of the images (15-25) and the source from which the images originate. In particular, referring to icon 50, it comprises a plurality of silhouettes (an outline representation of the edges) of the actual images 15-19 provided on the first side 12. Additionally, the icons may be composed of thumbnail (miniature) image representations of the actual images. In particular, there are provided silhouettes 55-59, each of which refers to the location of its respective image 15-19.

From this description of a silhouette, we find that appellants have acted as their own lexicographer in defining the silhouettes as a rectangular representation of

frames where the outline representation of the edges of the frames is the silhouette. From this disclosure, we find that the rectangles of Shiota, which represent the index print frames, meet the claimed silhouettes. Thus, we are not persuaded by appellants' assertion (brief, page 5 and reply brief, pages 2 and 3) that the prior art would not have suggested that the icon be a silhouette. Note that because appellants have specifically defined the term in the specification, we decline to use the definitions provided in the dictionary definitions provided by appellants in the reply brief. Accordingly, we agree with the examiner (answer, page 7) that:

In regard to appellant's argument on page 5, paragraph one of his brief that there is no teaching or suggestion of providing an icon in the form of a silhouette as taught and claimed by appellant in either above mentioned reference, the examiner submits that Shiota inherently provides silhouettes in its reduced images in the 4x4 matrix print icon 64.

Turning to Manico ('870), we find that the reference discloses in figure 9a an index print for developed photographic film. It is disclosed (col. 5, lines 2-5) that the right hand portion of the index print is provided with other data, such as an identification number and the date the index print was made. It is additionally disclosed (col. 5, lines 6-9) that if the individual film strips are taken from various different rolls of film, notations as to which rolls or subject matter they relate to can be printed in the right hand portion on the index print. From the disclosure of Manico ('870), we find that an artisan would have been motivated to provide the index prints with an identifier of the specific roll of film, as well as the frame number of the print.

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From all of the above, we find that the teachings and suggestions of Manico ('692), Shiota, and Manico ('870) would have suggested to an artisan the limitations of claim 2, and are not convinced of any error on the part of the examiner of rejecting claim 2 under 35 U.S.C. § 103(a). Accordingly, the rejection of claim 2, and claims 3-6, 14-18, 26-28, 30, 36, 41-45, and 53-56 under 35 U.S.C. § 103(a) is sustained.

We turn next to the rejection of claims 8, 20, 31, 37, and 59 under 35 U.S.C. § 103(a) as being unpatentable over Manico ('692) in view of Shiota and Werner. Appellants present no arguments regarding the claims of this group. From our review of the record and the lack of any arguments presented by appellants, we will sustain the rejection of claims 8, 20, 31, 37, and 59 under 35 U.S.C. § 103(a) for the reasons set forth by the examiner in the answer (page 5).

We turn next to the rejection of claims 9, 10, 21, 22, 32, 33, 48, 49, 60, and 61 under 35 U.S.C. § 103(a) as being unpatentable over Manico ('692) in view of Shiota and Combs. Appellants present no arguments regarding the claims of this group. From our review of the record and the lack of any arguments presented by appellants, we will sustain the rejection of claims 9, 10, 21, 22, 32, 33, 48, 49, 60, and 61 under 35 U.S.C. § 103(a) for the reasons set forth by the examiner in the answer (pages 5 and 6).

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CONCLUSION

To summarize, the decision of the examiner to reject claims 10, 12, 1-36 and 40-63, 46 and 47 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge

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Stuart S. Levy
STUART S. LEVY
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